

### REMARKS

The present application relates to hybrid maize plant and seed X1069G. Claims 5-8, 20, 33, and 42-63 have been canceled. Claims 63-90 has been added. No new matter has been added by the present amendment. Applicants respectfully request consideration of the following remarks.

#### Detailed Action

##### *A. Claim Objections*

Applicants acknowledge the objection of claims 51 and 53 under 37 C.F.R. § 1.75, as being duplicate claims of 20 and 33. Applicants have canceled claims 20, 33, 51 and 53, thus rendering this objection moot.

Applicants further acknowledge the objection of claims 43-45 and 48-50 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Although not acceding to the Examiner's objection, Applicants have canceled claims 43-45 and 48-50, thereby rendering this objection moot.

##### *B. Newly Submitted Claims*

Applicants acknowledge the addition of new claims 63 through 90 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 50; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 52-53; for phytase on page 53; and for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 53-54.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claim 8 remains and claims 46-50 and 61 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention.

Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicants have canceled claim 8, thereby rendering this rejection moot.

Claim 46 stands rejected as indefinite for the terminology "a transgenic X1069G hybrid" as the Examiner states it is unclear what the metes and bounds of the claimed methods are.

Applicants have now canceled claim 46, thus alleviating this rejection.

The Examiner rejects claim 49 for the recitation "derivative thereof or a synthetic polypeptide modeled thereto" rendering the claim indefinite.

Applicants have canceled claims 49, thereby alleviating this rejection.

Claim 61 stands rejected as indefinite for the recitation "utilizing".

Applicants have canceled claim 61, alleviating this rejection.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 46-50, 55, and 56 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed December 27, 2002.

Although not acceding to the Examiner's rejection, to expedite prosecution Applicants have canceled claims 5-8, 20, 33, and 42-63, thereby rendering this rejection moot. Applicants have added new claims 63-90 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 8, 42-44, and 57-62 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record in the Office Action mailed December 27, 2002.

Applicants traverse this rejection. Nevertheless, in order to expedite prosecution claims 8, 42-44, and 57-62 have been canceled and new claims 63-90 have been added as disclosed *supra*. Applicants request reconsideration.

Claims 8, 42-44, 46-50, and 55-62 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse this rejection. Applicants submit that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise in condition for allowance. As provided in 37 C.F.R. §§ 1.801-1.809, Applicants wish to reiterate they will refrain from deposit of hybrid maize plant X1069G and the inbred parents GE535769 and GE515721 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, description of the deposited biological materials sufficient to specifically identify and to permit examination and the name and address of the depository. The claims will also be amended to recite the proper ATCC deposit numbers. The Applicants provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and

e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicants submit at least 2500 seeds of hybrid maize plant X1069G and the inbred parents GE535769 and GE515721 will be deposited with the ATCC. Nevertheless, in order to expedite prosecution claims 8, 42-44, 46-50, and 55-62 have been canceled and new claims 63-90, have been added as disclosed *supra*.

In addition, Applicants assert that the introgression of mutant genes and transgenes is easily, routinely and extensively practiced by those of ordinary skill in the art. Backcrossing has been known since the 1920's and, because of its predictability, is the method preferred by commercial plant breeders to introduce transgenes into already developed and tested material. An example of how one of ordinary skill in the art can transfer a gene conferring a qualitative trait into a variety through backcrossing is demonstrated by the fact that the commercial market now distributes a multitude of products produced in this manner. Such conversion lines are easily developed without undue experimentation.

Further, the Applicants would like to reiterate that a patent application "need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986); MPEP § 601.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections to claims 8, 42-44, 46-50, 55-62 under 35 U.S.C. § 112, first paragraph.

#### **Issues Under 35 U.S.C. § 102/103**

Claim 62 stands rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Fullerton (U.S. Patent 6,169,234).

Applicants have canceled claim 62, thereby alleviating this rejection. Applicants acknowledge the addition of new claims 63 through 90, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Further, Applicants submit *In re Thorpe*, states that "a product by process claim may be properly rejected over prior art teaching the same product

produced by a different process", as noted by the Examiner. *In re Thorpe*, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985). However, Applicants submit that this is not the same product physiologically or morphologically as the cited prior art as can be evidenced by one skilled in the art through analysis of the data tables in each. In addition, it is impermissible to use hindsight reconstruction and the benefit of Applicant's disclosure to pick among pieces which are present in the art; there must be some suggestion to make the combination and an expectation of success. *In re Vaeck*, 20 U.S.P.Q.2d 1434 (Fed. Cir. 1991). Moreover, Applicants claim a method of making a plant which did not previously exist. Pursuant to the recent Federal Circuit decision, *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education & Research*, 304 F.3d 1221, (Fed. Cir. 2002), "a novel patented product is not 'anticipated' if it did not previously exist." *Id.* This is the case whether or not the process for making the new product is generally known. *Id.* The invention X1069G has not previously existed as it is the result of crossing two maize inbred lines GE535769 and GE515721 therefore Applicants strongly assert that neither the suggestion of the claimed unique invention of the present application nor the expectation of success is taught for one ordinarily skilled in the art in the reference cited by the Examiner.

In light of the above, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Fullerton (U.S. Patent 6,169,234).

### Summary

Applicants acknowledge that claims 1-7, 20, 33, 52, and 54 are allowed.

Applicants have amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicants submit the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

### Conclusion

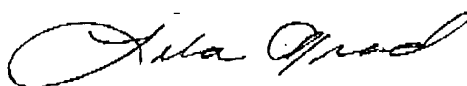
In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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